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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,254	01/08/2004	Douglas C. Schlueter	1921	6732

7590

02/22/2005

Alcon Research, Ltd.  
Patrick M. Ryan(Q-148)  
R&D Counsel  
6201 So. Freeway  
Fort Worth, TX 76134-2099

EXAMINER

REYES, HECTOR M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/753,254	<b>Applicant(s)</b> SCHLUETER, DOUGLAS C.	
	<b>Examiner</b> Hector M Reyes	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1 in part, 3-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/14/04 1/29/04</u> . | 6) <input type="checkbox"/> Other: _____   |

**DETAILED ACTION**

**ELECTION RESTRICTION REQUEST**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 in part, 2, 9 and 10, drawn to ester or amide derivatives disclosed in claims 1 and 2 and compositions comprising the same in ophthalmic materials classified in multiple classes and multiple subclasses. A single disclosed species is requested for search purposes.
- II. Claims 1 in part, 3, 9 and 10, drawn to keto-alcohol compounds disclosed in claims 1 and 3 and compositions comprising the same in ophthalmic materials classified in class 562, subclass 405+. A single disclosed species is requested for search purposes.
- III. Claims 1 in part, 4, 9 and 10, drawn to phosphorus derivatives disclosed in claims 1 and 4 and compositions comprising the same in ophthalmic materials classified in class 568, subclass 008+. A single disclosed species is requested for search purposes.
- IV. Claims 1 in part, 5-9 and 10, drawn to peroxides derivatives disclosed in claims 1 and 5-8 and compositions comprising the same in ophthalmic materials classified in class 568, subclass 558+. This group may be

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subjected to further restriction. A single disclosed species is requested for search purposes.

The inventions are distinct, each from the other because of the following reasons:

Inventions IV -I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions because each group is directed to compounds having a significantly different structure and composition comprising each set of compounds. Moreover, a particular composition prepared by the compounds embraced by any of the above Groups does not require the use of other compounds. Thus a given reference anticipating or suggesting any of the groups does not necessarily anticipate or suggest any of the other groups.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for a given Group is not required for any of the others Groups, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Mr. Patrick Ryan on 2/16/2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 in part, 2, 9 and 10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 in part, and 3-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **Status of The claims**

Claims 1 in part, 2, 9 and 10 directed to the diazo derivative described as [1] and products comprising the said diazo compounds as described in claims 9 and 10 are under Examination.

### **Claims Objected**

Claims 1 in part is objected because the said claims contain not elected subject matter.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the variable moiety R is defined as "a benzotriazole or benzophenone UV absorber". The said phrase is indefinite because it is unclear what substituents or organic groups may or may not be contain in the benzotriazole or benzophenone unit in

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order to clearly define compounds embraced by the said claims. Are future, not yet prepare benzotriazole or benzophenone derivatives embraced claim 1 definition? How is determine what particular benzophenone or benzotriazole derivatives are a UV absorber?

Furthermore, the point of attachment of the said benzotriazole or benzophenone to the remaining part of the molecule is not indicated thus it is unclear what is the chemical structure of the claimed compound(s). For the examination effects, the Examiner would consider:

- any possible substituted or nonsubstituted benzotriazole or benzophenone, wherein the substituents are located in any part of the corresponding rings and wherein the ring is attached to the rest of the structure at any possible location.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is anticipated by Sheppard et al US patent 3956269 (1976). Sheppard discloses compounds having a linkages as well as the radical of an ultraviolet stabilizing group.

Among the compounds described by Sheppard are:

Di-(3-hydroxy-4-benzoylphenyl)trans-4,4'-azobis(4-cyanovalerate), see column 33,

Example V. The said compounds is an species within the claimed genus [1] wherein:

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A is methyl

B is cyano

D is ethylene

E is oxygen

F is nothing and

G is R that is embrace by 3-hydroxybenzophenone unit.

Shepard also discloses Di-[2-(2hydroxybenzoyl)phenyl]cis-4,4'azobis(4-cyanovalerate), as described in column 32, under Example VI. The said compound is also a species within the claimed genus wherein;

A is methyl

B is cyano

D is ethylene

E is oxygen

F is nothing and

G is R that is embrace by 2-hydroxybenzophenone unit.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheppard et al, US patent 3956269 (1976) in view of Loshaek, US patent 4304,895 (1981).

Sheppard discloses compounds having a linkages as well as the radical of an ultraviolet stabilizing group. Among the compounds described by Sheppard are:

Di-(3-hydroxy-4-benzoylphenyl)trans-4,4'-azobis(4-cyanovalerate), see column 33,

Example V. The said compounds is an species within the claimed genus [1] wherein:

A is methyl

B is cyano

D is ethylene

E is oxygen

F is nothing and

G is R that is embrace by 3-hydroxybenzophenone unit.

Shepard also discloses Di-[2-(2hydroxybenzoyl)phenyl]cis-4,4'azobis(4-cyanovalerate), as described in column 32, under Example VI. The said compound is also an species



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within the claimed genus wherein;

A is methyl

B is cyano

D is ethylene

E is oxygen

F is nothing and

G is R that is embrace by 2-hydroxybenzophenone unit.

Sheppard also discloses that the said compounds are useful in polymers synthesis in order to provide UV light stabilization to a variety of materials, see column 26, lines 5-25.

Sheppard however, does not particularly point out the use of the said materials in the preparation of ophthalmic lens materials.

Nonetheless, Loshaek et al, US patent 4304895, teaches the preparation of UV light absorbing lenses that are prepared by copolymerizing with an UV absorber-monomer containing a unsaturated benzophenone as the see column 2, lines 6 to 29 and column 3, lines 25-55.

It would be obvious to a person skilled in the art to prepare azo UV absorber monomers as the ones disclosed by Sheppard and to further use the said in the preparation of materials requiring UV absorbers as for instance in ophthalmic lenses as recognized by Loshaek et al. A person skilled in the art would right away recognized that the polymer prepared with compounds such s compound VI had the greatest retention of flexural

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strength in runs 4-6, (see table II and column 27, lines 27-35), thus the said material would be highly convenient to be use in the preparation of ophthalmic lens materials.

### **CONCLUSION**

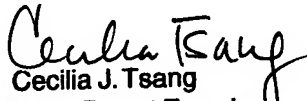
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes whose telephone number is (571) 272-0691. The examiner can normally be reached on M-F (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Cecilia Tsang, can be reach at 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hector M. Reyes PhD JD  
USPTO Reg. # P-54,846  
Au 1625  
February 18, 2005

Ms. Cecilia Tsang  
Patent Examiner Supervisor

  
Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600